

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Blair BIRMINGHAM

Title: METHOD AND SYSTEM FOR USING MULTIPLE OPERATING SYSTEMS

App. No.: 09/675,033 Filed: September 28, 2000

Examiner: Haresh N. PATEL Group Art Unit: 2154

Atty. Dkt. No.: 1376-0000900 Confirmation No.: 7656

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**REMARKS IN SUPPORT OF
THE PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In response to the Final Office Action mailed January 24, 2008 (hereinafter, “the Final Action”), and pursuant to the Notice of Appeal and Pre-Appeal Brief Request for Review submitted herewith, the Applicant requests review of the following issues on appeal.

Request for at least three examiners on the panel

In order to facilitate full consideration of the remarks filed herewith, the Applicant respectfully requests that the Art Unit Supervisor designate a panel composed of at least three examiners.

One skilled in the art would understand the terms “dedicated” and “general” as recited in the claims

At page 15 of the Final Action, claims 1-46 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. According to Section 2173.02 of the MPEP, “The test for definiteness under 35 U.S.C. 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’” (quoting *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)). Further, “[s]ome latitude in the manner of expression and the aptness of terms

should be permitted even though the claim language is not as precise as the examiner might desire.” MPEP § 2173.02.

With respect to claims 1, 7, and 18, and the claims respectively dependent thereon, the Final Action asserts at page 15 that the elements “appliance operating system dedicated to control the information handling device to operate a subset of the one or more appliances” are indefinite because the appliance operating system is used for multiple functions, and therefore “it is not apparent how the appliance operating system is dedicated.” *Final Action*, page 5. Applicant respectfully submits that one skilled in the art would understand that the term “dedicated” contrasts with the term “general” as set forth in the claims. In particular, as explained in the Response to Final Office Action submitted March 5, 2008 (hereinafter the “Previous Response”) with respect to claim 1, one skilled in the art would understand that the term “dedicated” refers to an appliance operating system that controls only a subset of appliances available to an information handling device, in contrast to the term “general”, which refers to an operating system that can control all of the components of the information handling device. This understanding of one skilled in the art is fully supported by the Specification at, for example, page 5 (“A general operating system located in a mass storage device, such as hard drive 140 of information handling device 100, controls general purpose computing tasks, such as running application programs, as needed”), page 6 (“Entertainment operating system 172 can be selected for controlling one or more of the media handling devices 120 with CPU 110 in information handling device 100. Entertainment operating system 172 is loaded to enable only the components of information handling device 100 that are needed for controlling the selected media handling devices 120”), and page 8 (“Despite the addition of quick-loading appliance specific operating systems, such as appliance operating system ROMs 170, a general operating system can be stored in a mass storage device, such as hard drive 140. If a user needs to control a separate appliance, or needs to perform other tasks, not covered by appliance operating system ROMs 170, the user can select to run a general operating system”).

With respect to claims 7 and 18, the claims do not use the term “dedicated”, but instead refer to a “general operating system” and an “appliance operating system.” For reasons similar to those set forth above with respect to claim 1, Applicant respectfully submits that one skilled in the art would understand these features of claim 7 and claim 18.

At pages 16-17 of the Office Action, the Office asserts that the terms “general operating system” and “general information handling system” of claims 1 and 7 are indefinite because they are relative terms. However, under MPEP § 2173.05(b), relative terms in a claim are permissible so long as “one of ordinary skill in the art would understand what is claimed, in light of the specification.” In this case, for reasons similar to those set forth above, one skilled in the art would understand the features of a “general operating system” and a “general information handling system.”

In addition, the Office’s assertion of indefiniteness relies upon a portion of the Specification of the present application that states “while a general operating system would be limited to controlling the built in CD player.” *Final Action*, page 17 (citing the *Specification*, page 7, lines 13-14). However, as explained in the Previous Response, the passage of the Specification cited by the Office reads in full as follows “In one embodiment, entertainment operating system 172 can control either the built in CD player, or the second CD player that is part of home theater 187, while a general operating system would be limited to controlling the built in CD player.” *Specification*, page 7, lines 11-14. Thus, the cited portion of the Specification points out that a general operating system is an operating system that controls all the components of an information handling system, and in some embodiments may not control peripheral appliances external to the information handling system that can be controlled by a dedicated appliance operating system. Accordingly, the terms “general operating system” and “general information handling tasks” are not indefinite.

One skilled in the art would understand the terms “concurrently” as recited in the claims

At page 17 of the Final Action, the Office asserts that the elements “executing ...operating systems concurrently” as set forth in claim 4, 22, and 26 are indefinite because “it is not apparent how the general operating system can perform general information tasks when the other appliance operating system is having its turn.” *Final Action*, page 17 (emphasis in original). The Office Action acknowledges at page 18 that there are a variety of techniques that support concurrently executing operating systems, but asserts that claims 4, 22, and 26 are indefinite because the “applicant failed to support how the claimed invention, and which technique in the specification, supports how the general operating system can perform general information tasks when the other appliance operating system is having its turn and

when the general operating system is waiting for its turn during concurrent processing.”

Office Action., page 18. Applicant respectfully submits that, as acknowledged by the Office, there are a variety of techniques for concurrently executing operating systems, whether by virtualization, multi-threaded processing, multi-core and multi-processor execution techniques, and other methods. Applicant further submits that one skilled in the art would understand that these techniques allow for the concurrently executing operating systems to perform their associated tasks.

In addition, to the extent the Office at page 18 of the Office Action relies upon the features of claim 3 to support its assertion of indefiniteness with respect to claim 4, Applicant respectfully submits that claim 4 does not depend from claim 3, and therefore any alleged inconsistency between claims 3 and 4 does not render either claim indefinite.

The Office’s proposed combination of references fails to consider the references in their entirety

At pages 19 of the Final Action, the Office’s obviousness rejection of several of the claims relies upon a proposed combination of Solomon and Watanabe. Rejections of other claims rely on a proposed combination of Watanabe with the Endo reference, other rejections rely on a proposed combination of Watanabe with the Ginter reference, and still others rely on a proposed combination of Watanabe with the Lee reference.

As explained in the Applicant’s Response to Office Action submitted October 24, 2007 (hereinafter “the October Response”), one skilled in the art would not make any of the proposed combinations with Watanabe, because such combination would result in one of the references being unsuitable for its intended purpose, and because there would be no reasonable expectation of success in making the combination. For example, the proposed combination of Solomon and Watanabe would render Solomon unsatisfactory for its intended purpose of providing a scheme to allow a computer to run multiple operating systems *concurrently*.

The Office responds in the Final Action that the proposed combinations are each based on a selective reading of Watanabe, rather than consideration of Watanabe in its entirety. For example, the Office states at page 5 of the Final Action that “there is no need to combine the system as applicant suggested (and/or irrelevant pieces) of Watanabe [sic] with Solomon

because the Watanable is relied upon to demonstrate the well-known concept/feature of using dedicated software" (emphasis in original). However, "[a] prior art reference must be considered **in its entirety**, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)) (emphasis added). Thus, there are no "irrelevant pieces" of the cited references for purposes of determining whether one skilled in the art would make the proposed combination. As explained in the October Response, considering the cited references *in their entirety* would lead one skilled in the art to not make the proposed combinations of cited references, because such combination would render one of the references unsuitable for its intended purpose of allowing a computer to run multiple operating systems concurrently. Thus, considering each of the cited references in their entirety, one skilled in the art would not combine the references as proposed by the Office, and therefore the proposed combinations are not a proper basis for the obviousness rejections.

Conclusion

As discussed above, the Office fails to establish that the cited references disclose or suggest each and every element recited by any of the pending claims. Accordingly, reconsideration and withdrawal of these rejections is respectfully requested.

Respectfully submitted,

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May 13, 2008

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